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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,818	12/19/2000	Antonio Alvarez Berenguer	2486-1-003	3449

7590

12/12/2001

David A Jackson  
Kaluber & Jackson  
411 Hackensack Avenue  
Hackensack, NJ07601

EXAMINER
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ART UNIT	PAPER NUMBER
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1755

# 3

DATE MAILED: 12/12/2001

**Office Action Summary**

Application No.

09/700,818

Applicant(s)

ALVAREZ BERENGUER ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) 9,10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 5-12 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

Applicant's election with traverse of Group I, claims 1-3, 5-8, and 11 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there is a single inventive concept. This is not found persuasive because the examiner has provided references under PCT 13.1 and 13.2 wherein it is only required to show that one of the Groups defines no technical contribution over the prior art. The examiner has done so and has provided several references that teach a composition comprising a clay such as sepiolite and modified natural gum such as guar gum. The applicants' amendment of their claim to limit their clay now to only "sepiolite" effectively removes all references which only teach attapulgite. However, the applicants are referred to remaining references in the below rejection such as Carter '023 which teaches a sorbent comprising sepiolite and guar gum which can be used as an animal litter composition. Carpenter, as an other example of the earlier references, teaches a spacer fluid additive comprising sepiolite and galactomannan gum (which would appear to be a modified natural gum in accordance with claim 1's limitations). The applicants are also referred to the newly cited references in the rejection which demonstrate additive compositions comprising sepiolite and guar gum and thus further demonstrate that the Group I additive provides no technical contribution over the prior art.

It would appear that applicants may not be familiar with the more recent rules regarding proper PCT restrictions regarding showing features of no technical contribution over the art. These are outlined in PCT Rules 13.1 and 13.2.

In response to the response time of only one month (versus the 3 month shortened statutory period), one month is proper because the requirement is only to

show that the restriction is proper and the additive would appear to define no technical contribution over the prior art.

The applicants also state that there is some sort of conspiracy to trap applicants into a prejudicial statement on the record. The examiner disagrees and notes that this is not the case and the examiner is only following the teaching and training of his own tech center which pointed out that certain US applications filed under PCT Rules (USC 371) can be restricted by showing no technical contribution over the prior art.. The examiner maintains that restriction by these PCT rules for US applications filed under 35 USC 371 is proper and the restriction is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patel, Chaux et al., Ricci et al., Keilhofer et al., Cowan et al., Carpenter et al., Carter, or Barat (FR 1505541).

**Patel** teaches a composition which is added as a viscosifying agent or additive which comprises guar gum (claim 6) and a clay such as sepiolite (claim 9) thus anticipating the instant invention. If not anticipated, the applicants' claimed invention would appear to be obvious to one of ordinary skill in the art because it is essentially a viscosifying agent<sup>or additive.</sup>

**Chaux et al.** teach a composition comprising guar gum (claim 3) and an argilla (claim 8) which can be sepiolite (see col.7, <sup>lines</sup> ~~lines~~ 25-30) thus anticipating the claimed invention. Although not explicitly stated, the composition can be considered as a whole an additive since it is added to an aqueous medium for hydrosol preparation and thus at least obvious to one of ordinary skill in the art.

**Ricci et al.** teach a rheological *additive* for aqueous systems comprising a clay such as sepiolite and a polymeric material (see claim 1). Ricci et al. teach that their polymeric material can include guar gum, tragacanth gum and xanthan gum which would all appear to be modified natural gums thus anticipating the claimed invention.

**Keilhofer et al.** teach a composition comprising a clay mineral such as sepiolite (claim 2) and further including a polysaccharide such as guar gum (claim 8) thus anticipating the instant invention. Although not explicitly stated, the composition as a whole is an additive that is added as a thickening agent for water based drilling fluids and thus would at least render obvious the applicants' invention to one of ordinary skill in the art.

**Cowan et al.** teach a cement coated sorbent which is also comprised of guar gum water soluble polymer (col.8, line 35) and a water sorption capacity powdered clay

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enhancer such as sepiolite (col.8, line 47) thus anticipating the instant invention. The composition as a whole would at least have been obvious to one of ordinary skill in the art since it can be considered a sorbent additive to an animal litter composition.

**Carpenter et al.** teach a spacer fluid additive comprising sepiolite clay and a natural modified gum such as welan gum (see claim 13) thus anticipating the instant invention. Although not explicitly stated, the composition as a whole is an additive that is added as a thickening agent for water based drilling fluids and thus would at least render obvious the applicants' invention to one of ordinary skill in the art.

**Carter** teaches a sorbent additive composition comprising a particulate earth clay substrate such as sepiolite (see claim 1 and column 3, lines 54-67, in particular line 65) and a polysaccharide such as guar gum thus anticipating the instant invention. The composition as a whole would at least have been obvious to one of ordinary skill in the art since it can be considered a sorbent additive to an animal litter composition.

**FR 1505541** teaches a composition comprising sepiolite and guar gum thus anticipating the instant invention. FR '541 or Barat teaches the composition can be an additive or agent for use in forest fire prevention and thus would at least have been obvious to one of ordinary skill in the art.

Finally, it is noted that all the references would appear to *be free of cellulose derivatives* even though this would appear to be a new matter limitation.

Claims 1-3, 5-8 and 11 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed would not appear to provide support for the now claimed invention.

The terms "free of cellulose derivatives" would appear to be new matter unsupported by the original disclosure in newly amended claim 1. Should applicants convincingly show where they derive support for these terms, the rejection will be withdrawn. Otherwise, it would be upheld.

Claims 1-3, 5-8, and 11 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term "special" mortar is vague and indefinite in claim 1. What is the special mortar specifically? Applicants may consider deletion of this term since its vague.

The terms "selected from" is improper markush language in claim 1 and throughout the claims (e.g. claim 6 also). However, it is also noted that applicants claim 1 only requires that "one" of the solid mineral components be present. In other words, the invention can presently read upon a sepiolite additive or a modified natural gum additive. Applicants may wish to consider to delete "selected from" and replace with --- solid mineral component containing clay and at least a modified natural gum....----  
Note that this would at least make the presence of both a clay and modified natural gum required components in claim 1.

The word galctomanane would appear to be incorrectly spelled in claim 7.

The terms "use of" in claim 11 is rejected also under the first paragraph of 35 USC 101 since it is not a statutory class of invention and also is thus indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. The examiner can normally be reached on 4-10 Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

December 4, 2001



PAUL MARCANTONI  
PRIMARY EXAMINER  
GROUP 1700